

REMARKS/ARGUMENT

A copy of the Reexamination Certificate is attached.

A Supplemental Reissue Declaration is attached in which applicant states that all errors which are being corrected by this reissue application up to the date of the declaration (including as to the Preliminary Amendment of April 6, 2001), arose without any deceptive intention on his part. It is respectfully submitted that the rejection of claims 1 and 4-30 as based on the defect in the reissue declaration has been overcome by the attached Supplemental Declaration.

The Examiner is respectfully requested to reconsider and withdraw the rejection of claim 26 under 35 U.S.C. 112. The Examiner's position appears to be that the original patent disclosure does not disclose a nozzle plate that has an *insertable* nozzle. In this connection, the Examiner's attention is directed to column 3, lines 55-56 of the patent. This specifically describes nozzle 84 as insertable. It is respectfully submitted that this is entirely sufficient support for the recitation in claim 26.

The Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 4-15, 20, and 22-30 on the basis of the "recapture doctrine". As will be demonstrated below, these claims are not directed to subject matter which was abandoned during the prosecution of the application for the patent upon which this reissue application is based. Each purported instance of attempted recapture will be dealt with separately.

Amendment Of The Limitation *sealing means surrounding the discharge end of the water passage including a seal member surrounding the discharge end of the water passage . . .*
In Claims 1 And 12:

This limitation now reads

a seal surrounding the discharge end of the water
passage . . .

Applicant acknowledges that the limitation in question was added to claim 1 (and was included in claim 19, which became patent claim 12), by the amendment filed August 5, 1996.

Applicant does not, however, agree that this change was made to distinguish the claimed subject matter from the prior art (specifically, U.S. Patent 3,094,283). The Examiner has stated that “according to applicant’s arguments accompanying this amendment, this change occurred to more specifically define the sealer of the instant invention from the prior art.” However, what was also said in the Remarks accompanying the August 8, 1996 amendment with respect to the Balister patent was:

applicant’s seal is in a different location and serves a different function albeit that both are seals...The Examiner’s attention is called to the fact that the claims as originally presented included the sealing element as one of the necessary elements in the combination. The claims have been amended to more definitely define this element which clearly distinguishes over Balister.

Careful consideration thus shows that what applicant was attempting to do in this amendment was to explicitly define the location of the seal (“surrounding the discharge end of the water passage and dimensioned to continuously bare against said inner surface...”).

Claim 1 as originally filed called for a providing “a sealed connection”, and thus implicitly recited a seal. In conjunction with the other features added by the August 8, 1996 amendment, the seal was recited explicitly, but making explicit what was previously implicit does not narrow a claim. Claim 1 was narrowed by the recitation that the seal “. . . [surrounded] . . . the discharge end of the water passage . . .”, as this specified the location of the seal in comparison to the location of the seal in Balister. However, *that limitation is still in claim 1.*

Claim 1 still recites the same essential structure (i.e., the “seal surrounding the discharge end of the water passage”) as in claim 1 of the original patent. The only changes that have been made in this reissue application are elimination of the redundant phrase “sealing means surrounding the discharge end of the water passage formed in said nozzle housing, said sealing means including”, and the unnecessarily limiting “means plus function” language. Accordingly, it is respectfully submitted that the rejection should be withdrawn as to this aspect of claims 1 and 12.

Deleting From Claim 1, The Limitation “. . . means

for retaining said rotatable sleeve in place . . .”:

The Examiner has asserted that the limitation in question was added to claim 1 by the amendment of January 15, 1997 in response to a rejection. Careful consideration will reveal, however, that the subject limitation could not have been added to claim 1 to distinguish it from the prior art. Indeed, in retrospect, the January 15, 1997 amendment appears to have been the result of careless housekeeping.

In the Office Action dated October 29, 1996, claims 1 and 9 (*inter alia*) were rejected under 35 U.S.C. 102 as anticipated by the Saint-Raymond French patent 2,313,132. Claim 9 as originally presented, was dependent on claim 6, but that claim was cancelled by the amendment dated August 8, 1996. Thus, claim 9 had no parent claim as of October 29, 1996.

This informality was noted and objected to by the Examiner in Section 1 of the October 29, 1997 Office Action, and applicant responded in the January 15, 1997 amendment by cancelling claim 9, and incorporating the recitation of claim 9 (i.e., “means for retaining said rotatable sleeve in place”) into claim 1. In the Remarks, applicant argued that claim 1 was patentable over Saint-Raymond for several reasons, and these reasons were evidently persuasive, because the rejection was withdrawn, and the application was allowed.

Whatever persuaded the Examiner to allow claim 1, it was most definitely not the inclusion of the limitation “means for retaining said rotatable sleeve in place” from original claim 9. For one thing, this limitation was never mentioned in applicant’s arguments. More importantly, however, this limitation does not distinguish the claim over the Saint-Raymond patent. Sleeve 32 in the reference has means for retaining it in place.

Realistically, there is no way to determine at this point why claim 9 was not made dependent on claim 1, as assumed by the Examiner in Section 1 of the October 29, 1997 Office Action. Since something had to be done about the dependency of claim 9, perhaps it just seemed neater to combine the two claims because the limitation in question did not distinguish over the reference. That would be pure speculation, however, and it is certainly not reasonable to assume that

the limitation would have been added distinguish over the prior art would, when it, in fact, does not do so.

In any case, it is clear in retrospect, that adding the limitation was an error, and that applicant is entitled to correct this error by reissue. There is no reason for the Examiner to question applicant's assertion that the error was without deceptive intention. Accordingly, it is respectfully submitted that the rejection should be withdrawn as to this aspect of claim 1.

**Addition of New Claims 22-30 Which Are
Broader than Original Patent Claims 16-19:**

Applicant is somewhat puzzled by this ground for rejection. Indeed, it seems that present claim 22, which specifies that the nozzle can be changed while the sprinkler is operational, and claim 29, which broadly recites a nozzle plate, have been characterized as an attempted recapture simply *because* they are broader than claims 16-19 of the patent.

New claims 22 and 29 are broader than patent claim 16 (added to the original application as claim 23) in that the selectable nozzle arrangement of claim 22, and the nozzle plate of claim 29 are not required to be:

mounted over the outer surface of . . . [the sprinkler]
. . . housing to rotate therewith and . . . [be] . . .
manually rotatable relative to said housing . . .

It is respectfully submitted that claims 22-30 should be regarded as a legitimate attempt to secure broadened coverage of a combination for which protection was inadvertently (and without deceptive intention) not sought in the original application. No claims of the scope of these claims were canceled from the original application, and no broader claims directed to this subject matter were ever narrowed in response to a rejection in the original application or during the re-examination.

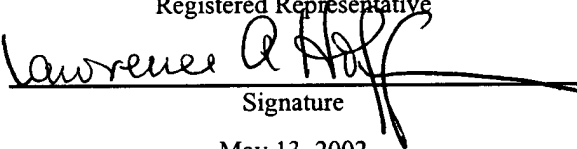
The fact that more limited claims were *added* to the application does not preclude applicant from now seeking claims of broader scope. Since the combination of a rotatable sprinkler mounted on a riser, and having a nozzle plate is not shown in the prior art, failure to include claims

of that scope in the original application, or to add them later, is clearly the kind of error which can legitimately be corrected by reissue and should not be regarded as an attempt to recapture subject matter abandoned to overcome prior art..

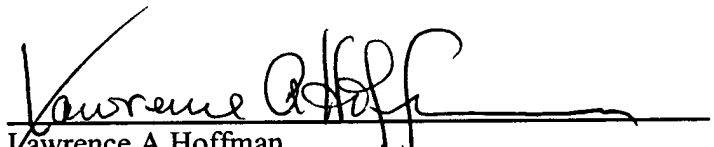
Since the Examiner has no basis for questioning applicant's declaration that these claims were omitted without deceptive intention, it is respectfully submitted that the rejection should be withdrawn as to claims 22-30.

In view of the foregoing, favorable reconsideration and allowance of this application are respectfully solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231, on May 13, 2002:

Lawrence A Hoffman
Name of applicant, assignee or
Registered Representative

Signature
May 13, 2002
Date of Signature

Respectfully submitted,


Lawrence A Hoffman
Registration No.: 22,436
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700

LAH:sam:dmk